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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/305,562	06/08/1999	MARVIN A. ORNSTEIN	ORN-3.0-004	2313

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EXAMINER

CAPRON, AARON J

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/305,562

Applicant(s)

ORNSTEIN ET AL. 

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 49- 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 and 49- 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.


MARK SAGER
PRIMARY EXAMINER**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is a response to the Amendment received on August 5, 2002, in which claims 1-2, 4, 11, 15-19, 21-22, 24, 30, 38, 42, 45 and 49 were amended, claims and claims 46-48 were cancelled. Claims 1-45 and 49-50 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-45 and 49-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim language is asserting that in a world of infinite possibilities that there is no mathematical chance that any one combination of betting chips has a total weight that equals the weight of any one betting chip. For example, if a chip equaling 1 monetary unit (mu) weighs X grams and a chip equaling 5mu weighs (X+1) units. A player having 5 chips equaling 1mu can equal one chip equaling 5mu where $X=0.25$ ($5X=X+1$). Further, since one can include that one betting chip can be interpreted as a stack of chips having the similar denomination, it is quite possible that a large combination of chips could have an equal weight to a large stack of similar chips. For example, a player can have a 1mu weighing 10.3 and a 5mu weighing 11.3. By manipulating values, a player having 113 1mu and 103 5mu would have equivalent weights

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($10.3X=11.3Y$; $X=113$ and $Y=103$). Therefore, it has been determined that the claims, as listed above, are not enabling.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi in view of Filiberti.

Referring to claims 1-3, Franchi discloses a betting system that includes an area provided at each player location for receiving chips; the area having weighing means for determining whether the player is participating and to determine the chip based upon its weight (Column 11, lines 26-12:7), but does not disclose the weighing means or using betting chips that have different weight denominations. However, it is notoriously well known to distinguish betting chips, such as coloring and size, based upon the monetary values. Since Franchi discloses that chips of different values have different weight (11:65-12:1), the chips would have to have distinguish the number of chips in order to determine the chip's monetary value and the weight of the chips would have to be distinguishable enough in order to determine the monetary value of a pile of chips. Further, in order to correctly determine combination of betting chips from another combination stack of betting chips stack from another, the weights of the chips would

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have to be distinguishable enough so that a pile of chips should not equal another pile of chips. Furthermore, it is notoriously well known in the gaming arts that casinos use a wide variety of betting chips that include one, five, twenty-five and one-hundred monetary units. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the monetary value based on weight in order to help limit dealers from skimming money from the casino.

Referring to claim 4, Franchi does not disclose the chips of one, five, twenty-five and one hundred monetary units having weights of X , $X+1$, $X+6.4$, and $X+26.3$ units. Absent such a specific limitation being critical to the invention, the limitation of the weights does not serve to define or to determine patentability. Such admissions are ordinary in the selection process in the course of the design. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use various weights of chips for the purposes of meeting the differentiation of the chips.

Claims 6-9, 12-13, 29 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi in view of Filiberti.

Referring to claims 6 and 9, Franchi discloses a betting system but does not disclose using an A/D converter. However, Filiberti discloses using an A/D converter coupled to a load cell for determining the weight and the number of coins (Column 4, lines 56-59). One would be motivated to combine the two references since both refer to determining the total amount of money based upon weight. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the A/D converter into Franchi's betting

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system because the more accurate the signal, the better the casino and patrons are for having an accurate money count.

Referring to claims 7 and 8, Franchi discloses a betting system but does not disclose using a table look up means or a memory for storing monetary values. However, Filiberti discloses performing tests on the coins and determine the proper denomination (Column 3, lines 35-40) which would be stored in a table where the controller would be able to gain a count on the coins stored in the memory (Column 4, lines 30-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the table look up means in Franchi's betting system because it is conventional to have databases to store data in a table format.

Claim 12 corresponds in scope to a method set forth for use of the system listed in claims 1-10 and are encompassed by use as set forth in the rejection above.

Referring to claim 13, Franchi discloses a method for playing a game but does not disclose transferring values to a remote location through a communication link. However, Filiberti discloses using a communication link to send coin counts to authorize employees for verification (Figure 4; column 5, lines 26-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the communication link to the method for playing a game because a communication link would limit the amount of theft by dishonest employees.

Claims 29 and 31-32 correspond in scope to a method set forth for use of the structure listed in claims 1-4, 6-9 and 13 and are encompassed by use as set forth in the rejection above.

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Claims 33-35, Franchi discloses using a betting card that has a magnetic strip (Column 2, lines 38-54) to identify the player and a console to read the information off the card (Figure 3).

Claims 5, 10, 30 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi in view of Ornstein et al. (U.S. Patent No. 5,788,574; hereafter "Ornstein").

Referring to claims 5 and 10, as shown above, Franchi shows a betting system where weight of the coin can determine the monetary value of the bet in place, but does not disclose having a second area for receiving a side bet. However Ornstein discloses having a second area for receiving a side bet (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Ornstein's side bet into the table of Franchi's because games that include side bets would generate more interest among patrons of a casino.

Referring to claim 30, Franchi shows a betting system that uses the weight of a coin can determine the monetary value of the bet in place, but does not disclose using chips that are the same size. However, Ornstein used chips of the same size that have a color band and a signal to differentiate the difference between two different denominations. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the same size of the chip into the weight because both forms (weight and signal) can be used to differentiate between the value of chips.

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Claims 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi in view of Filiberti in view of Ornstein further in view of Ornstein (U.S. Patent No. 5,718,431; hereafter "Ornstein '431").

Referring to claims 49-50, as shown above Franchi in view of Filiberti discloses a betting system that uses weight to determine the amount of the bet, while Ornstein discloses using additional areas for receiving side bets, but none of these references disclose using a marker to keep track of the number of consecutive wins. However, Ornstein '431 discloses using markers to keep track of the number of consecutive wins (Figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate using markers into the betting system because a dealer must keep track of the number of games play and the markers would allow for less mistakes.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 38 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 42 and 44 of U.S. Patent No. 5,788,574 in view of Franchi.

U.S. Patent No. 5,788,57 discloses the features of the use of a betting unit, but does not disclose using a weighing sensor. However, as shown above, Franchi discloses using a weigh cell to determine whether a player is playing a game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the weigh cell for the betting unit because the betting unit would become more automated and possibly be used without a dealer.

Claims 11, 14-24, 25-28 and 40-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 9-13, 15, 17, 19, 22, 23, 25 and 28 of Ornstein et al. (U.S. Patent No. 5,788,574; hereafter "Ornstein") in view of Franchi in further view of Filiberti.

Referring to claims 11, 14-18 and 40-45, Ornstein discloses a method for incorporating one or more bets for a game of chance, but does not disclose using weight of the chip at a certain spot and converting the weight to a monetary value. However, as shown above, Franchi in view of Filiberti discloses determining the weight of the chip wagered and converting the weight determined to a monetary value. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the weighing means into the game of chance because by weighing the chips to determine the value would speed the game since the dealer does not have to examine the chips.

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Referring to claim 19 and 21-23, as shown above, Ornstein discloses a betting system but does not disclose using a table look up means or a memory for storing monetary values of money. However, Franchi in view of Filiberti discloses performing tests on the coins and determine the proper denomination which would be stored in a table where the controller would be able to gain a count on the coins (and the total money) stored in the memory. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the table look up means in Ornstein's betting system because the use of memory would allow authorized personnel to review the games for tampering.

Referring to claim 20 and 24, Ornstein discloses a betting system but does not disclose using an A/D converter. However, Franchi in view of Filiberti discloses using an A/D converter coupled to a load cell for determining the weight and the number of coins. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the A/D converter into Ornstein's betting system because the more accurate the signal, the better the casino and patrons are for having an accurate money count.

Referring to claims 25-28, Ornstein discloses a method for incorporating one or more bets for a game of chance, but does not disclose using weight of the chip at a certain spots and converting the weight to a monetary value. However, as shown above, Franchi in view of Filiberti discloses determining the weight of the chips wagered and converting the weight determined to a monetary value. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the weighing means into the game of chance because by weighing the chips to determine the value would speed the game since the dealer does not have to examine the chips.

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Response to Arguments

Applicant's arguments with respect to claims 1-45 and 49-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc
October 24, 2002



MARK SAGER
PRIMARY EXAMINER